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Application No.: 10/627,313
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Docket No. A-3-4

REMARKS

General Comments

Claims 54-70 are pending in the subject application.

Rejection of Claims under 35 U.S.C. §103(a)

According to the Office Action, claims 54-56, 59-70 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,682,596 to Bales et al. ("Bales") in view of U.S. Patent No. 4,326,529 to Doss et al. ("Doss").

It is well established that an Office Action must establish a *prima facie* case of obviousness in order to reject claims under 35 U.S.C. § 103. To establish a *prima facie* case of obviousness, at least three basic criteria must be met: 1) there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 706.02(j).

In this instance, there is not motivation to combine the references. Bales states the "electrosurgical device of the present invention employs the application of electric current directly to an area of plaque or tissue buildup for resolving, ablating or removing the buildup ..." (emphasis supplied). Col. 2, lines 65-67. Thus, Bales teaches that the electric current is applied directly to the tissue, and not through an intermediate layer. To provide an electrically conductive liquid as mentioned in Doss contradicts the teachings of Bales because it would create current paths outside or indirect to the tissue. Indeed, the current may travel through the fluid and not through the tissue. This contradicts the teachings of Bales and may render the primary reference inoperable. Based on the foregoing, Applicant submits a *prima facie* case of obviousness is not properly established and requests reconsideration and withdrawal of the rejections of the claims.

Applicant also requests reconsideration and withdrawal of the rejections of claims 57-58 because these claims depend from the claims described above and are patentable for at least the reasons indicated above.

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Applicant has made a sincere effort to respond to each and every issue raised in the Office Action. Should the Examiner wish to contact the Applicant he is encouraged to do so at the below referenced number.

Respectfully submitted,



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